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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,689	07/09/2003	Robert L. Doubler	ZMS-G02US	8552

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EXAMINER	
REESE, DAVID C	

ART UNIT	PAPER NUMBER
3677	

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01/07/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/618,689	DOUBLER ET AL.	
	Examiner	Art Unit	
	David C. Reese	3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 October 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) *6-9,11-13,15,16 and 18* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,10,14,17 and 19-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.1 14, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/17/2007 has been entered.

Certain art from the IDS filed by applicant on 10/17/2007 has been deemed applicable to the current claims listing by the examiner and therefore applied to meet the structural limitations of the claims as amended and entered (as shown in the examiner's amendment) in the previous Notice of Allowance by the examiner. Therefore, the indication of allowable subject matter has been rescinded and accordingly, claims 1-5, 10, 14, 17, and 19-26 are found to be unpatentable over the prior art of record. New grounds of rejection follow.

Status of Claims

- Claims 6-9, 11-13, 15-16, and 18 are withdrawn (Due to the retraction of allowable generic claims).
- Claims 1-26 are pending.

Claim Rejections - 35 USC § 102

[1] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

[2] Claims 1-5, 10, 17, and 26 are rejected under 35 U.S.C. 102(e(1)) as anticipated by Wu et al., US-2004/0260283.

The shape and appearance of Wu et al. is identical in all material respects to that of the claimed design, *Hupp v. Siroflex of America Inc.*, 122 F.3d 1456, 43 USPQ2d 1887 (Fed. Cir. 1997).

As for Claim 1, Wu et al. discloses a linear fastener system comprising:

a collet member (15) having a base end, a top end, an inner engaging surface (16), and an outer ribbed surface (17) positioned about a central axis, said outer ribbed surface defining peaks and valleys;

a compression ring member (31) having a base end, a front end, an inner ribbed surface defining peaks and valleys having the same shape as the peaks and valleys of said outer ribbed surface (17) so as to be complementary to said peaks and valleys of said outer ribbed surface (17) of said collet member (15) and an outer surface positioned about a central axis;

said inner ribbed surface of said compression ring member (31) being constructed and arranged for coaxial alignment and overlapping engagement with respect to said outer ribbed surface (17) of said collet member (15), said compression ring member (31) *[non-rotationally linearly traversable with respect to said outer ribbed surface (17) of said collet member (15)

between a first release position and a second engaged position, wherein said engaged position results in said outer ribbed surface (17) of said collet member (15) and said inner ribbed surface of said compression ring (31) compressing said collet member (15) and tensilely loading said compression ring (31) member to engage a shank member (32) having an outer gripping surface whereby said collet member (15) is clamped to the shank member (32) without rotating said collet member (15), and wherein said release position results in said peaks of said collet member being entirely disposed in said valleys of said compression ring for expansion of said collet member (15) thereby releasing the outer gripping surface of the shank member (32)]*.

*Examiner's note: the above statement in brackets is an example of intended use language; language that in the instant case fails to further limit the structure of the claimed invention. The prior art only needs to be capable of performing said function to be anticipatory, and in the instant case, the compression and collet member of Wu et al. are capable of satisfying the relationship of structural limitations as afforded by the functional nature of both the released and engaged positions as described by the claim above (the peaks of both the collet and compression member are capable of being in compression against one another; and the peaks and valleys of said collet and compression member are capable of being entirely disposed within one another) by simply forcing one set of threads non-rotatably downward against the other set of threads.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Re: Claim 2, wherein said shank member (32) includes a first end and a second end.

Re: Claim 3, wherein said ribbed outer surface (17) of said collet member (15) includes at least one outwardly and circumferentially extending rib (17), each said rib (17) including a first ramp surface to facilitate coaxially aligned linear overlapping movement of said compression ring (31) in relation to said collet member (15) for engagement thereof, and a second ramp surface to facilitate linear removal of said compression ring (31) from said collet member (15).

Re: Claim 4, wherein said inner engaging surface of said collet member (15) is constructed and arranged with a conjugate shape in relation to said outer gripping surface of said shank member (31).

Re: Claim 5, wherein said inner engaging surface of said collet member (15) constructed and arranged with internal threads (16).

Re: Claim 10, wherein said first end of said shank member (32) includes a tensioning means (see fig. 4), said tensioning means being constructed and arranged to allow said shank member (32) to be tensilely loaded prior to linear traversal of said compression ring member (31) into said engagement position with respect to said collet member (15).

Re: Claim 13, wherein said shank member tensioning means (see fig. 4) includes at least one internal bore extending inwardly from said first end of said shank member (32) along the longitudinal centerline of said shank member (32), wherein said at least one internal bore is constructed and arranged for gripping and placing a tensile load on said shank member (32) prior to linear traversal of said compression ring member (31) into said engagement position with respect to said collet member (15).

Re: Claim 17, wherein said outer ribbed surface (17) of said collet member (15) and said inner ribbed surface of said compression ring member (31) are constructed and arranged to maintain an axially aligned interfitting relationship in said release position.

As for Claim 26, Wu et al. discloses a linear fastener system comprising:

a collet member (15) including an outer ribbed surface (17) defining peaks and valleys, and an inner surface (16) adapted to grip a corresponding surface of a shank (32) in a locked condition of said fastener system and

a compression ring (31) including an inner ribbed surface defining peaks and valleys having the same shape as the peaks and valleys of said outer ribbed surface (17) so as to be corresponding to said peaks and valleys (17) of said collet member (15);

[the linear fastener system having a locked condition wherein said peaks of said collet member (15) and said peaks of said compression ring (31) are in confronting alignment, and an unlocked condition wherein said peaks of said collet member (15) are disposed in said valleys of said compression ring (31), whereby said collet member (15) may be clamped to the shank (32) in said locked condition without rotating said collet member (15)].

*Examiner's note: the above statement in brackets is an example of intended use language; language that in the instant case fails to further limit the structure of the claimed invention. The prior art only needs to be capable of performing said function to be anticipatory, and in the instant case, the compression and collet member of Wu et al. are capable of satisfying the relationship of structural limitations as afforded by the functional nature of both the unlocked and locked positions as described by the claim above (the peaks of both the collet and compression member are capable of being in compression against one another; and the peaks and

valleys of said collet and compression member are capable of being entirely disposed within one another) by simply forcing one set of threads non-rotatably downward against the other set of threads.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

[3] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

[4] Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wu et al., US-2004/0260283.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

Wu et al., discloses that of the above claims. The difference between the claim and Wu et al. is that Wu et al. does not expressly disclose that the internal bore includes threads.

Examiner takes official notice that it is old and well known to use threads as an alternative method by which to fasten one substrate to another. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have replaced the hexagonal bore with internal threads as to provide an alternative means by which to insert the component into the fastening assembly; that is, by using threads as opposed to a socket. Further, it would have been obvious to a person of ordinary skill in the art to make such an alteration as a person with ordinary skill has good reason to pursue the known options within his or her technical grasp in order to gain the commonly understood benefits and applications of such an adaptation and/or modification.

[5] Claims 19-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu et al., US-2004/0260283, in view of case law.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

The difference between the claims and Wu et al. is that Wu et al. does not expressly disclose the different materials that may constitute the parts of his device. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to create the device out of plastic (claim 19), copper (claim 20), brass (claim 21), bronze (claim 22), aluminum (claim 23), steel (claim 24), and/or rubber (claim 25), since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its

suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. It is also common knowledge to choose a material that has sufficient strength, durability, flexibility, hardness, etc. for the application and intended use of that material.

Conclusion

[6] THIS ACTION IS NON-FINAL

[7] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30 am-6:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Katherine Mitchell can be reached at (571) 272-7069. The fax number for the organization where this application or proceeding is assigned is the following: (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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DCR

ROBERT J. SANDY
PRIMARY EXAMINER